



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,255	04/06/2001	W. Graeme Rouston	41456/SAH/W396	4984
23363	7590	10/25/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			KIM, NICHOLAS J	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	
			3622	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/828,255	Applicant(s) ROUSTON ET AL.	
	Examiner Nicholas Kim	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6 Apr 01, 9 Oct 01</u> . | 6) <input type="checkbox"/> Other: _____ |

ch

DETAILED ACTION

Information Disclosure Statement

1. The Supplemental Information Disclosure Statement (IDS) submitted on 9 October 2001, was filed after the mailing date of the utility application on 6 April 2001. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the IDS is being considered by the examiner.

Specification

2. The disclosure is objected to because of the following informalities: Appendix A and Appendix B are not included in the filed application. Appendices A and B are respectively referenced at p. 13, l. 6 and at p. 14, l. 16, of Applicants' specification. Appropriate correction is required.

3. Applicant is reminded of the proper language and format for an Abstract of the disclosure. In particular, the Abstract should avoid using phrases which can be implied, such as "The invention is directed toward..." MPEP at § 608.01(b).

Claim Objections

4. Claim 19 is objected to because of the following informalities: "relation" at line 2 should read "relating". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3622

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 3-4, 6-8, 12-21, and 22-28 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. In particular, Claim 12 recites “an employee” at line 8. It is unclear to which previous recitation of “employee/s” this limitation refers. Also, Claims 18 and 19 recite “sufficient number.” It is unclear how many frequent flyer miles is a sufficient number. MPEP at §2173.05(c) III.

8. Additionally, Claim 3 recites the limitation “the respective employees’ accounts” at lines 2-3. Claims 4 and 14 recite the limitations “the number” at lines 3-4 and “the amount” at line 4. Claim 6 recites the limitations “the employee’s credit card” at lines 1-2 and “the number” at lines 2-3. Claim 7 recites the limitation “the number” at line 3. Claim 12 recites the limitation “the appropriate member account” at lines 10-11. Claim 16 recites the limitations “the employee’s credit card” at line 2 and “the number” at lines 2-3. Claim 17 recites the limitations “the employer’s account” at lines 1-2 and “the number of existing member accounts” at lines 2-3. Claim 18 and 19 recite the limitation “the redemption of a sufficient number” at lines 2-3. Claim 22 recites the limitation “the members” at line 6. Claim 27 recites the limitation “the respective members” at lines 3-4. Claim 28 recites “the respective members’ accounts” at line 3. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

Art Unit: 3622

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-5 and 9-11 are rejected under 35 U.S.C. 102(e) as anticipated by Postrel (U.S. Patent No. 6,594,640).

11. Beginning with Claim 1, Postrel teaches Applicants' claimed method, including accruing a number of frequent flyer miles (Postrel at Col. 1, ℓ. 30-35), redeeming a selected number of the frequent flyer miles to receive a benefit in connection with a business-related airline ticket purchase (Postrel at Col. 3, ℓ. 20-23), and receiving a corresponding incentive (Postrel at Col. 3, ℓ. 20-23). It is noted that Applicants' recited "corresponding incentive" is interpreted to correspond to the previously recited "benefit," wherein the benefit is interpreted to be received by either the employer or the employee.

12. Postrel also teaches the limitations of Claim 2, including creating an account for the employee (Postrel at FIG. 8), and that receiving a corresponding incentive includes crediting the employee's account (Postrel at Col. 6, ℓ. 47-52, step 620).

Art Unit: 3622

13. With regard to Claims 3-4, Postrel discloses recording accrued frequent flyer mile information in the respective employees' accounts (Postrel at Col. 6, ℓ. 25-27) and that crediting the employee's account includes crediting the account by an amount based on at least one of the number of frequent flyer miles redeemed and the amount of the benefit received (Postrel at Col. 6, ℓ. 4-52).

14. Addressing Claim 5, Postrel discloses that receiving a corresponding incentive includes receiving at least one of a voucher for airline travel, credits for airline travel, and credits that can be exchanged for goods and/or services (Postrel at Col. 3, ℓ. 57 – Col. 4, ℓ. 43).

15. Turning to Claims 9-11, Postrel describes that accruing frequent flyer miles includes accruing at least one of personal and business-related frequent flyer miles (Postrel at Col. 1, ℓ. 30-35) and that redeeming a selected number of the frequent flyer miles includes redeeming a sufficient number of the frequent flyer miles to receive a discount on a business-related airline ticket purchase and a free or upgraded business-related airline ticket (Postrel at Col. 3, ℓ. 20-23). It is noted that receiving a free upgrade is equivalent to receiving a discount on a higher-class ticket. Similarly, a free ticket is a type of discounted ticket.

16. Claims 12-15 and 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by Toh et al. (Toh, Rex S., C. Patrick Fleenor, and David W. Arnesen, "Frequent-Flier Games: The Problem of Employee Abuse," Academy of Management Executive, Vol. 7, No. 1, 1993, p. 60-72, herein "Toh").

17. Toh discloses all limitations recited in Applicants' Claim 12, including creating a client account for the company (Toh at p. 65-66, "Corporate Response"), receiving employee-related

Art Unit: 3622

data from the company and creating member accounts for the respective employees of the company (Toh at p. 66, “to monitor ...”, “business-related account”), receiving information relating to a redemption of a selected number of frequent flyer miles by an employee in connection with a business-related airline ticket purchase (Toh at p. 66, “business trip”), and providing a corresponding benefit to the appropriate member account (Toh at p. 66, “cash incentives”).

18. With regard to Claims 14-16, Toh also describes that the step of providing a corresponding benefit includes crediting the employee's member account with a number of credits (Toh at p. 66, “half the amount ...”) and that crediting the employee's account includes crediting the account by an amount based on at least one of the number of frequent flyer miles redeemed and the amount of the benefit received (Toh at p. 66, “half the amount...”), and that the step of providing a corresponding benefit includes providing at least one of a voucher for airline travel, credits for airline travel, and credits that can be exchanged for goods and/or services (Toh at p. 66, “cash payment”).

19. Toh further teaches all recited limitations of Applicants' Claims 18-20, including that the step of receiving information includes receiving information relating to the redemption of a sufficient number of the frequent flyer miles to receive a discount on a business-related airline ticket purchase and a free business-related airline ticket (Toh at p. 66, “flags bonuses as they are earned”, “free tickets”), and recording accrued frequent flyer mile information in the respective members' accounts (Toh at p. 66, “keeps tabs...”, “business-related account”). As described above, a free ticket is a type of discounted ticket.

Art Unit: 3622

20. Claims 22-28 are rejected under 35 U.S.C. 102(e) as anticipated by Postrel.

21. Postrel provides a system including an interface to communicate over a communication network (Postrel at FIG. 4) and a processor programmed to create a plurality of member accounts and operative in response to the receipt of frequent flyer mile redemption information by one of the members to credit the corresponding member account (Postrel at FIG. 4 at 10, 12, 14, 20, and 40), limitations recited in Applicants' Claim 22.

22. With regard to Claim 23, Postrel also describes that the processor is programmed to process a request by a member to exchange credits, generate appropriate exchange information, and update the member's account (Postrel at FIG. 6)

23. Turning to Claims 24-27, Postrel teaches that the processor is operative to communicate with at least one of a shopping server and travel server relating to an exchange of credits by a member (Postrel at FIG. 5 at 54), to communicate with a credit card processing server in connection with a redemption of frequent flyer miles by a member (Postrel at FIGs. 2-3 and FIG. 4 at 12), to create a client account for a company, and to receive employee-related information from the company to create the member accounts (Postrel at FIG. 4 and FIG. 5 at 54), to create a plurality of member accounts based on employee-related information received, and to interact with the respective members to activate said member accounts (Postrel at FIGs 4 and 8).

24. Postrel also teaches the limitations recited in Claim 28, including that the processor is programmed to record accrued frequent flyer mile information in the respective members' accounts (Postrel at FIG. 4 at 52).

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claim 6 is rejected under 35 U.S.C. 103(a) as unpatentable over Postrel in view of Calder (Calder, Simon, "Air Miles Devalued By Extra Charges," The Independent, Apr 2, 1999, p. 9) and further in view of Wiesendanger (Wiesendanger, Betsy, "Employees' Frequent-Flier Miles Hijacked," Sales and Marketing Management, 145, 9, Aug 1993, p. 24-25).

27. Concerning Claim 6, Postrel does not explicitly teach charging the employee's credit card an amount corresponding to the number of frequent flyer miles redeemed. Calder teaches charging an employee an amount corresponding to the number of frequent flyer miles redeemed ("... face sharp increases in the amount they must pay to redeem 'free' flights"). However, Calder does not explicitly teach charging an employee's credit card. Wiesendanger explicitly teaches this limitation (Wiesendanger at 25, "plastic is the weapon of choice"). Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Postrel as taught by Calder using the mode of payment taught by Wiesendanger for advantageously increasing revenues for airlines while improving the management of travel expenses for companies (Calder at 1/1, "... means to increase fares"; Wiesendanger at p. 25, "The top reason...").

Art Unit: 3622

28. Claim 7 is rejected under 35 U.S.C. 103(a) as unpatentable over Postrel in view of McConnell et al. (U.S. Patent No. 6,373,930, herein McConnell).

29. With regard to Claim 7, Postrel does not explicitly teach creating an account for each employer, and billing the employer's account based on the number of existing employee accounts. However, McConnell expressly provides this limitation (McConnell at Col. 2, ℓ. 5-15). Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Postrel as taught by McConnell for advantageously managing the use of services based on a measure of subscriber accounts (McConnell at Col. 1, ℓ. 20-21).

30. Claim 8 is rejected under 35 U.S.C. 103(a) as unpatentable over Postrel in view of Business Wire ("XTRA On-Line's PowerTrip to Include Frequent Flyer Management Service; Business Travelers Get Added Perk When Making Travel Plans," Business Wire, Jul 24, 1998, p. 1).

31. Postrel does not explicitly teach each of the limitations recited in Claim 8. However, Business Wire provides entering an agreement with a third party, creating accounts for the employers referred by the third party, and compensating the third party (Business Wire at 2/2, "... sold to travel agencies that then distribute the product to their corporate clients..."). Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Postrel as taught by Business Wire for advantageously enabling travel agents to provide frequent flyer management services (Business Wire at 1/2, "'When you ask ...'").

Art Unit: 3622

32. Claim 16 is rejected under 35 U.S.C. 103(a) as unpatentable over Toh in view of Calder and further in view of Wiesendanger.

33. Concerning Claim 16, Toh does not explicitly teach charging the employee's credit card an amount corresponding to the number of frequent flyer miles redeemed. Calder teaches charging an employee an amount corresponding to the number of frequent flyer miles redeemed (“... face sharp increases in the amount they must pay to redeem ‘free’ flights”). However, Calder does not explicitly teach charging an employee's credit card. Wiesendanger explicitly teaches this limitation (Wiesendanger at 25, “plastic is the weapon of choice”). Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Toh as taught by Calder using the mode of payment taught by Wiesendanger for advantageously increasing revenues for airlines while improving the management of travel expenses for companies (Calder at 1/1, “... means to increase fares”; Wiesendanger at p. 25, “The top reason...”).

34. Claim 17 is rejected under 35 U.S.C. 103(a) as unpatentable over Toh in view of McConnell.

35. With regard to Claim 17, Toh does not explicitly teach creating an account for each employer, and billing the employer's account based on the number of existing employee accounts. However, McConnell expressly provides this limitation (McConnell at Col. 2, ℓ. 5-15). Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Toh as taught by McConnell for advantageously managing the use of services based on a measure of subscriber accounts (McConnell at Col. 1, ℓ. 20-21).

36. Claim 21 is rejected under 35 U.S.C. 103(a) as unpatentable over Toh in view of Business Wire (“XTRA On-Line’s PowerTrip to Include Frequent Flyer Management Service; Business Travelers Get Added Perk When Making Travel Plans,” Business Wire, Jul 24, 1998, p. 1).

37. Toh does not explicitly teach each of the limitations recited in Claim 21. However, Business Wire provides entering an agreement with a third party, creating accounts for the employers referred by the third party, and compensating the third party (Business Wire at 2/2, “... sold to travel agencies that then distribute the product to their corporate clients...”). Accordingly, it would have been obvious to one skilled in the art at the time of Applicants’ invention to modify Toh as taught by Business Wire for advantageously enabling travel agents to provide frequent flyer management services (Business Wire at 1/2, “When you ask ...”).

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to Applicants’ disclosure. Storey (U.S. Patent No. 5,774,870), Walker et al. (U.S. Patent No. 6,327,573), Crapo (U.S. Patent Pub. No. 2004/0064371), Chien et al. (U.S. Patent Pub. No. US 2001/0054003), Heintzeman et al. (U.S. Patent No. 5,483,444), and Lynch et al. (U.S. Patent No. 6,018,715) each disclose systems and methods relating to at least one of frequent flyer / loyalty point redemption or corporate travel management. Jonas (Jonas, David, “In Battle for Traveler Loyalty, Corps. Innovate,” Business Travel News, Vol. 16, Iss. 9, Apr 26, 1999, p. 40, 44) describes frequent flyer program management that incentivizes travelers. PR Newswire (“United Airlines Invites

Art Unit: 3622

Mileage Plus Members and Businesses to Purchase Miles Online,” PR Newswire, Oct 1, 1999, p.

1) describes the use of miles by businesses as promotional incentives for customers or

employees. Bornemeier et al. (Bornemeier, James and Alan C. Miller, “Rule Lets Lawmakers

Count Frequent Flier Miles for Personal Use,” Los Angeles Times, Jun 17, 1992, p. 3) describes

miles for personal and business use. Barlow (Barlow, Jim, “Company Can Use Its Fliers’

Mileage,” Houston Chronicle, Jul 22, 1999, p. 1) describes employees using miles for an upgrade

from coach and compensating the employee for miles used. Cohen (Cohen, Laurie P., “Some

Employers Get Tough On Use of Air-Travel Prizes,” Wall Street Journal, Mar 22, 1985, p. 1)

describes IVI Business Travel International’s software to return employee miles to a company.

Smith (Smith, Carol, “Companies Lobby for Discounts, Not Mileage,” Los Angeles Times, Jul

14, 1994, Sec. D, p. 4) describes several software programs for corporate frequent flyer

management including IVI’s TrackPlus, Corporate Services International, and efforts by

companies that monitor point activity of their employees. Yenckel (Yenckel, James, “Corporate

Frequent Flyers: What’s Air Fair?” Arizona Republic, Aug 11, 1991, p. T.1) describes the RAN

Decisions program to help companies reclaim employees’ miles for future business travel.


39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Kim whose telephone number is (571) 272-1392. The examiner can normally be reached on Monday - Friday 8am - 4:30pm.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NJK



JEFFREY D. CARLSON
PRIMARY EXAMINER